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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,240	06/29/2006	Jcoun-Jun Hwang	7045P003	9202
8791 7590 05/23/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
LSTVOYB, GREGORY				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/585,240

**Applicant(s)**

HWANG ET AL.

**Examiner**

GREGORY LISTVOYB

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

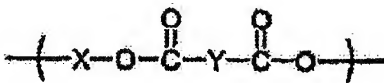
Claims 1, 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al (US 2002/0049285) herein Abe in combination with Phelps et al (US 6436548) herein Phelps.

Abe discloses a method for preparation of polyester copolymer having amide links comprising copolymerizing a cyclic amide (i.e. caprolactam, see line 0023, meeting the limitations of Claim 5) and a cyclic ester with carbon atom number of C3-C12 (see line 0068), where the amount of the ester is within the range of 1-99% (see line 0037, meeting the limitations of Claim 6).

Abe does not disclose that his cyclic ester is an oligoester.

Phelps discloses a macrocyclic polyester and method of its preparation (see Abstract).

Phelps discloses macrocyclic polyester oligomer includes the repeating unit of the following formula:



(see column 4, line 15) where X represents alkylene radical or oxyalkylene radical having more than 2 Carbon atoms (see Column 3, line 10), and Y represents aromatic or alicyclic radical, and the number of the repeating unit in the macrocyclic polyester oligomer is 2 to 20 (see Column 4, line 20).

Regarding Claims 3 and 4, Phelps discloses a method for preparing polyester Copolymer where the macrocyclic polyester oligomer is obtained by reacting bis(hydroxyalkyl)ester, with dicarboxylic acid chloride in the presence of unhindered amine (see Column 4, line 35) and alternative method where the bis(hydroxyalkyl)ester is obtained by depolymerizing polyester resin (see Column 4, line 55).

Macrocyclic polyesters possess very low melt viscosity, which makes them desirable in forming melted articles with complex shapes (see Phelps, Column 1, line 30). In addition, low melt viscosity makes the process more economical, since lower energy needed to process the polymer.

Therefore, it would have been obvious to a person of ordinary skills in the art to use Phelps's macrocyclic polyesters in Abe's compositions in order to produce articles with

complex shapes and make the process more economical by lowering energy consumption.

### ***Response to Arguments***

Applicant's arguments filed on 1/29/2008 have been fully considered but they are not persuasive.

The Applicant argues that the (b1) cyclic ester of Abe includes lactone of the carbon number of from 3 to 12 (for example, 13- propiolactone, 13-butyrolactone, 13-valerolactone, and so on, (See paragraph [0068]), and the (b2) linear ester includes polyesterpolyol, polyesteretherpolyol or polycarbonatepolyol, but not macrocyclic polyester. However, in the Office Action the Examiner has never stated that Abe teaches macrocyclic polyester, which is disclosed by Phelps. Note, that both references drawn to the same esterification reaction. As stated in the previous Office Action, macrocyclic polyesters possess very low melt viscosity, which makes them desirable in forming melted articles with complex shapes (see Phelps, Column 1, line 30). Abe teaches that his material aims to use as a molded articles in electronic applications, which can have complex shapes. Therefore, it is desirable to have low viscosity of the melt to avoid high pressure/temperature during the processing of the above articles. In order to achieve the above properties, oligoester with low melt viscosity of Phelps can be used.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY LISTVOYB whose telephone number is (571)272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

GL

